



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/075,183

02/14/2002

Yoshiaki Wani

09792909-5341

7271

26263

7590

01/26/2007

SONNENSCHN NATH & ROSENTHAL LLP

P.O. BOX 061080

WACKER DRIVE STATION, SEARS TOWER

CHICAGO, IL 60606-1080

EXAMINER

CANTELMO, GREGG

ART UNIT

PAPER NUMBER

1745

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

01/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/075,183

Applicant(s)

WANI ET AL.

Examiner

Gregg Cantelmo

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 12-24 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the amendment received November 8, 2006:
  - a. Claims 1-9, 12-24 and 26-27 are pending;
  - B. The prior art rejections relying on Rosler as the primary reference of record is withdrawn in light of the amendment to the claims.
  - c. The 103 rejections relying on WO '008 as the primary reference of record stand.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 1745

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3, 5-7, 20 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of U.S. Patent No. 5,819,917 (Nicholson), U.S. Design Patent No. D 433,562 (Redlinger), all of record and also either U.S. Patent Nos. 5,829,591 (Lyons), 4,509,656 (Rosler '656) or 5,680,949 (Rosler '949).

WO '008 discloses a case including a main body 2 having a first opening portion at one end and a bottom surface 7 at the other end, and a lid portion 1 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural projection trains 11 run along the length of the main body to the bottom of the body (first and second trains) a third projection train 6 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 1).

Since the structure of the case of WO '008 has a telescoping arrangement wherein the cover can be held at various positions along the length of the body 2 dependent upon which projection train the cover meshes with, the prior art is clearly capable of storing multiple components within the casing. And again the limitations of claim do not positively require the batteries be present in the case nor specify the dimensional relationship between the size of the batteries relative to the size of the case. The shape and dimension of the casing of WO '008 is a telescoping case which

Art Unit: 1745

can store more than one device within the telescoping container. Again the claims do not require that batteries are clearly present but only a configuration of the casing relative to battery devices which could be stored in it.

The body and lid have a circular cross section (Fig. 1 and abstract) which is inherently made up of plural circular arc segments (as applied to claims 2 and 3).

Projection portion of trains 11 at the bottom of the body 2 are "substantially the same diameter" as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 6).

WO '008 teaches of a plurality of trains in which any number of grouping of trains can be incorporated into a given grouping of claims such that one group is a plurality of trains and the other group is a singular terminal train (as applied to claims 26-27).

Plural projection trains are provided on the body and shows a plurality of additional trains formed between the outer first and second trains of the body (as applied to claim 20).

The differences between claims 1, 5 and 7 and WO '008 are that WO '008 does not teach of providing a through-hole in the head portion of the lid (claim 1) of deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (claim 1), of the bottom surface expanded toward the outside via a circumferential ring (claim 5), wherein the through hole has a concave

Art Unit: 1745

portion and a cylindrical portion (claim 7), of the portion of the main body having a narrower cross-section as recited in claim 28.

With respect to the lid having a through hole (claims 1, 5 and 7):

Nicholson discloses that an attachment means provided to at least one of the cover or body of the casing 10 permits attachment of the casing 10 to other devices (see Fig. 1).

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides an attachment point on the container and permits attaching the container to other means.

The motivation for configuring the lid to have the through hole placed and configured as defined in claims 5 and 7 permits attachment of the container to a key ring whereat additional elements can also be attached to the ring.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

It would have further been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by configuring the

Art Unit: 1745

lid to have the through hole since it would have permitted attachment of the container to a key ring whereat additional elements could also be attached to the ring.

With respect to of deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (claim 1):

While WO '008 discloses inserting in the longitudinal direction without deforming the trains and then rotation the body and lid to secure the trains of the lid and body to one another, the concept of deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction is held to be an alternative and equivalent means for securing the body and lid.

Rosler '656 discloses deforming projection trains 5 extending along the entire surface of the body which then mate with train 5 of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1 and 5). Rosler '949 discloses deforming projection trains 5 extending along the entire surface of the body which then mate with train 8 of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1 and 5). Lyons discloses deforming projection trains 18 extending along the entire surface of the body which then mate with train 26B of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1, 8, 10 and 11).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 to replace the exemplary body and lid interlocking mechanism of WO '008 with any of the deformation

Art Unit: 1745

of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction shown by Rosler '656, Rosler '949 or Lyons since they're considered equivalent mechanisms for inserting and removing a body of a container to any number of depths relative to the lid is held to be an alternative and equivalent means for securing the body and lid.

With respect to the narrower cross-section:

Redlinger teaches of the casing wherein the body has an open end with the cross-section of the open end being narrower than the remainder of the body (see Fig. 1 of Redlinger).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by providing a narrower cross-section to the open end of the body is to enhance the ease of insertion of the body into the lid.

### ***Response to Arguments***

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

4. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of U.S. Patent No. 5,819,917 (Nicholson) and U.S. Design Patent No. D 433,562 (Redlinger) and either Rosler '659, Rosler '949 or Lyons as applied to claim 1 above and in further view of U.S. patent No. 5,829,591 (Lyons).



The difference not discussed is providing a stopper between the 1<sup>st</sup> and 2<sup>nd</sup> projection trains.

The concept of providing a stopper to the body of the casing is known in the art for the purposes of preventing the cover from covering the entire body. If the cover were able to cover the entire body, it would render it difficult to remove the body from the covering. Therefore a stopper means somewhere near or at the bottom of the body (the body end furthest from the cover receiving end of the body) would have provided such an arrangement (See Fig. 1 of Lyons).

While Lyons does not teach of providing the stopper between the 1<sup>st</sup> and 2<sup>nd</sup> projection trains, the placement of such is held to be a matter of design choice and that one of ordinary skill in the art would have found it obvious to place the stopper at somewhere near or at the bottom of the body (the body end furthest from the cover receiving end of the body) to prevent the body from being completely inserted into the cover.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the body of WP '008 to include a stopper as somewhere near or at the bottom of the body (the body end furthest from the cover receiving end of the body) suggested by Lyons since it would have prevented the body from being completely inserted into the cover. Furthermore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the body to have the stopper disposed near the end of the body and between the first

Art Unit: 1745

and last trains on the body since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

***Claim Rejections - 35 USC § 103***

5. Claims 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson and either Rosler '656, Rosler '949 or Lyons.

The case comprises a first projection train 11 on the body 2 near the bottom surface of the body and a second projection train 6 formed on the lid 1 near the open end of the lid, wherein the second projection train is adapted to engage the first projection train (Fig. 1 as applied to claim 16).

The body and lid have a circular cross section (Fig. 1 and abstract) which is inherently made up of plural circular arc segments (as applied to claims 18 and 19).

Plural projection trains are formed on the main body along the span of the body and thus there is a multiple projection trains formed on the main body near the bottom surface and the second projection train (on the lid) is adapted to engage the projection trains (first or third trains) on the main body (Fig. 1 as applied to claim 20).

The differences between claim 16 and WO '008 is that WO '008 does not teach of the main body storing a battery or of the deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction

As to the battery limitation of the claims:

Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of WO '008 and one of ordinary skill in the art would have found it obvious to configure the size of the container of WO '008 to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

With respect to of deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (claim 16):

While WO '008 discloses inserting in the longitudinal direction without deforming the trains and then rotation the body and lid to secure the trains of the lid and body to one another, the concept of deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction is held to be an alternative and equivalent means for securing the body and lid.

Rosler '656 discloses deforming projection trains 5 extending along the entire surface of the body which then mate with train 5 of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1 and 5). Rosler '949 discloses deforming projection trains 5 extending along the entire surface of the body which then mate with train 8 of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1 and 5). Lyons discloses deforming projection trains 18 extending along the entire surface of the body which then mate with train 26B of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1, 8, 10 and 11).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 to replace the exemplary body and lid interlocking mechanism of WO '008 with any of the deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction shown by Rosler '656, Rosler '949 or Lyons since they're considered equivalent mechanisms for inserting and removing a body of a container to any number of depths relative to the lid is held to be an alternative and equivalent means for securing the body and lid.

***Response to Arguments***

6. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson and either Rosler '656, Rosler '949 or Lyons applied to claim 16 above and further in view of U.S. Design Patent No. D 433,562 (Redlinger).

The teachings of claims 16 with respect to WO '008 have been discussed above and are incorporated herein.

The difference between claim 17 and WO '008 is that WO '008 does not teach of providing a through-hole in the head portion of the lid (claim 17).

WO '008 is broadly drawn to a container which can be used as a container for any number of items.

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides a an attachment point on the container and permits attaching the container to other means.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson and either Rosler '656, Rosler '949 or Lyons as applied to claim 16 above and further in view of U.S. Design Patent No. D 433,562 (Redlinger).

The teachings of claims 16 with respect to WO '008 have been discussed above and are incorporated herein.

The difference between claim 21 and WO '008 is that WO '008 does not teach of the casing having a cross-sectional shape as a pair of glasses.

The combination of WO '008 in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim.

The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement of the batteries in a single battery casing.

9. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson, Design Patent No. 409,560 (Shim) and either Rosler '656, Rosler '949 or Lyons.

WO '008 discloses a case including a main body 2 having a first opening portion at one and a bottom surface 7 at the other end, and a lid portion 1 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural projection trains 11 run along the length of the main body to the bottom of the body (first and second trains) and another projection train 6 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 8).

Projection portion of trains 11 at the bottom of the body 2 are "substantially the same diameter" as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 14).

The differences between claims 8 and WO '008 are that WO '008 does not teach of the main body having a cross-section shaped as a pair of glasses (claim 8) or of deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (claim 8).

With respect to storing batteries in the container (claim 8):

WO '008 is broadly drawn to a container which can be used as a container for any object.

Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of WO '008 and one of ordinary skill in the art would have found it obvious to configure the size of the container of WO '008 to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

With respect to configuring the case of WO '008 in view of Nicholson to have a cross-sectional shape as a pair of glasses:

The combination of WO '008 in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim (as applied to claim 8).

The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement of the batteries in a single battery casing.

With respect to of deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (claim 8):

While WO '008 discloses inserting in the longitudinal direction without deforming the trains and then rotation the body and lid to secure the trains of the lid and body to one another, the concept of deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction is held to be an alternative and equivalent means for securing the body and lid.

Rosler '656 discloses deforming projection trains 5 extending along the entire surface of the body which then mate with train 5 of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1 and 5). Rosler '949 discloses deforming projection trains 5 extending along the entire surface of the body which then mate with train 8 of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1 and 5). Lyons discloses deforming



projection trains 18 extending along the entire surface of the body which then mate with train 26B of the lid. Deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction (Figs. 1, 8, 10 and 11).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 to replace the exemplary body and lid interlocking mechanism of WO '008 with any of the deformation of the trains during insertion and extraction of the main body into or out of the lid portion in a lengthwise direction shown by Rosler '656, Rosler '949 or Lyons since they're considered equivalent mechanisms for inserting and removing a body of a container to any number of depths relative to the lid is held to be an alternative and equivalent means for securing the body and lid.

10. Claims 9, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson, Shim and either Rosler '656, Rosler '949 or Lyons as applied to claim 8 above, and further in view of Redlinger.

The differences not yet discussed are of the head portion and through-hole arrangement defined in claims 9, 13 and 15.

Nicholson discloses that an attachment means provided to at least one of the cover or body of the casing 10 permits attachment of the casing 10 to other devices (see Fig. 1).

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides a an attachment point on the container and permits attaching the container to other means.

The motivation for configuring the lid to have the through hole placed and configured as defined in claims 9, 13 and 15 permits attachment of the container to a key ring whereat additional elements can also be attached to the ring.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

It would have further been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by configuring the lid to have the through hole since it would have permitted attachment of the container to a key ring whereat additional elements could also be attached to the ring.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson, Shim and either Rosler '656, Rosler '949 or Lyons as applied to claim 8 above, and further in view of U.S. Patent No. 4,596,340 (Luther).

The difference not yet discussed is of the bottom surface expanded towards the outside.

There is no apparent criticality or significance disclosed as to this particular expanded surface and is construed as a matter of design choice.

Rosler '340 provides an expanded base extension on the bottom surface of the body which serves as a base support while providing an aesthetic design to the bottom of the surface.

It is generally regarded that in the absence of any significant criticality to the particular design of the bottom surface, this design is held to be an aesthetic design and is not a patentable distinction over the prior art rejections of record. In re Seid , 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Ex parte Hilton, 148 USPQ 356 (Bd. App. 1965).

***Response to Arguments***

12. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of U.S. Patent No. 5,819,917 (Nicholson), U.S. Design Patent No. D 433,562 (Redlinger) and either Rosler '656, Rosler '949 or Lyons as applied to claim 1 above and in further view of Design Patent No. 409,560 (Shim).

The difference between claims 24 and WO '008 are that WO '008 does not teach of the casing being capable of storing four batteries when the third projection train engages a second projection train and storing two batteries when the third projection train engages the first projection train.

With respect to storing batteries in the container:

Art Unit: 1745

WO '008 is broadly drawn to a container which can be used as a container for any object.

Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of WO '008 and one of ordinary skill in the art would have found it obvious to configure the size of the container of WO '008 to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

With respect to configuring the case of WO '008 in view of Nicholson to have a cross-sectional shape as a pair of glasses:

The combination of WO '008 in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim.

The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement of the batteries in a single

Art Unit: 1745

battery casing. In providing the combined telescoping container with a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement, the container would have been capable of storing either two batteries when the body is full inserted into the cover and capable of storing four batteries when the body is fully extended from but still in mating relationship with the cover via the terminal projection train of each of the body and cover.

### ***Response to Arguments***

14. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
gc  
January 22, 2007

Gregg Cantelmo  
Primary Examiner  
Art Unit 1745